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Inventor: Michael Steffen

Assignee: Wacker Neuson SE

Invention: *Internal Vibrator Provided with a Liberation Device*

Priority: German Patent Application No. 103 33 555.2; Filed 23 July 2003

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF CONFERENCE REQUEST

Dear Sir:

A Notice of Appeal is filed concurrently herewith. The Office is hereby authorized to charge deposit account 50-1170 the amount of \$540.00 for the Notice of Appeal filed herewith. Applicant has filed a Response to the Final Office Action mailed May 7, 2010 wherein claims 7-10 and 20-22 have been cancelled on an even date herewith. Appellant hereby requests pre-appeal review of the final rejection of claims 1-6 and 15-19. No amendments are being filed with this Request. The review is requested for the reasons set forth below.

Pending Claims

1. (Previously Presented) An internal vibrator device, comprising:
 - an electric motor,
 - a vibrator housing,
 - an imbalance device situated in the vibrator housing and driven by the electric motor so as to be capable of rotation, and
 - a main switch for switching the electric motor on and off,
 - the electric motor being capable of being operated, in a normal operating state, with a rotational characteristic suitable for the compacting of liquid concrete, wherein an operating state change device by which the internal vibrator device is able to be operated in a liberation operating state in which the rotational characteristic of the electric motor differs from the rotational characteristic in the normal operating state, in such a way that via the operating state change device the direction of rotation of the electric motor is capable of being reversed automatically at periodic time intervals.
2. (Previously Presented) An internal vibrator device according to Claim 1, wherein, via the operating state change device the direction of rotation of the electric motor is capable of being reversed in relation to the direction of rotation in the normal operating state.
3. (Previously Presented) An internal vibrator device according to Claim 1, wherein the operation of the electric motor is capable of being interrupted at periodic time intervals via of the operating state change device.

4. (Previously Presented) An internal vibrator device according to Claim 6, wherein the time duration of the periodic time intervals is able to be fixedly predetermined, or is variable.

5. (Previously Presented) An internal vibrator device according to Claim 1, wherein the rotational speed of the electric motor is capable of being modified or is capable of being controlled by means of the operating state change device.

6. (Previously Presented) An internal vibrator device according to Claim 1, wherein the vibrator housing, the electric motor, and the imbalance device are combined to form a vibrator device, the vibrator device being capable of being made to pass through its natural frequency through a modification of the rotational speed of the electric motor.

7-14. (Cancelled)

15. (Previously Presented) An internal vibrator device according to Claim 1, wherein the operating state change device further comprises an automatic operation switch that switches the operating state change device off and on.

16. (Previously Presented) An internal vibrator device according to Claim 1, wherein the operating state change device further comprises a period duration selection switch that sets the duration of the periodic time intervals.

17. (Previously Presented) An internal vibrator device, comprising:
- an electric motor,
- a vibrator housing,
- an imbalance device that is situated in the vibrator housing and that is driven to rotate by the electric motor, and

- an operating state change device that is connected to the electric motor and that automatically reverses the direction of the electric motor at periodic time intervals to operate the internal vibrator device in a liberation operating state in which the rotational characteristic of the imbalance device differs from the rotational characteristic in a normal operating state, the operating state change device including

- a main switch for switching the electric motor on and off, the electric motor normally operating in the normal operating state to drive the imbalance device with a rotational characteristic suitable for compacting liquid concrete, and

- an automatic operation switch that switches the operating state change device off and on.

18. (Previously Presented) An internal vibrator device according to Claim 17, wherein the operating state change device further comprises a period duration selection switch that sets the duration of the periodic time intervals.

19 (Previously Presented) An internal vibrator device according to Claim 17, wherein the operating state change device further comprises a reverse switch that reverses the direction of the electric motor when the electric motor is operating in the normal operating state.

20-22. (Cancelled)

REMARKS

Claims 1-6 and 15-19 are currently pending as previously withdrawn claims 7-10 and claims 20-22 have been cancelled in the Response filed September 7, 2010 to the Office Action mailed May 7, 2010. In the Office Action mailed May 7, 2010, the Examiner rejected claims 1-6 and claims 15-19 under 35 U.S.C. §102(b) as being anticipated by WO 00/61344 (which corresponds to U.S. Patent 6,808,384 to Jordan et al.). A telephone conference with the Examiner was held on May 13, 2010 with the undersigned Attorney Timothy Newholm (Reg. No. 55,782) and Attorney Kirk Deheck (Reg. No. 55,782) discussing the outstanding rejections of the pending claims. Applicant erroneously believed a resolution had been reached and filed a Response to the Office Action on June 21, 2010 that it believed conformed with the results of the interview. The amendments presented in that response were refused entry in the Advisory Action mailed June 29, 2010. With confirmation of the interests of the client, Applicant conducted a second telephone interview with the Examiner on September 7, 2010. It was evident during the second telephone interview that the applicant and Examiner had varying recollections of the results of the first interview and that an impasse had been reached with respect to the patentability and allowability of claims 1 and 17. As Applicant has cancelled claims 20-22, only the rejection of claims 1-6 and 15-19 are germane to this Pre-appeal Brief Conference Request.

In the Office Action mailed May 7, 2010, the only outstanding rejection of claims 1-6 and 15-19 is under 35 U.S.C. §102(b) as being anticipated by WO 00/61344 corresponding to Jordan et al. U.S. Patent 6,808,384. As discussed during both of the telephone conferences mentioned above, claim 1 defines, inter alia, an internal vibrator device including an operating state change device by way of which the internal vibrator device is able to be operated in a liberation operating state in which the rotational characteristic of the electric motor differs from the rotational characteristic in the normal operating state, in such a way that via the operating state change device the direction of rotation of the electric motor is capable of being reversed automatically at periodic time intervals. Claim 17, as presented prior to the final Office Action of May 7, 2010, calls for, in part, an operating state change device that is connected to the electric motor and that automatically reverses the direction of the electric motor at periodic time

intervals. The operation change state device recited in both claims, when operated, can assist in unjamming a vibrator that is jammed or caught in its sheath. See, e.g., page 1, line 16 to page 2, line 21. In the disclosed embodiment, the operating state change device is activated by a manually actuated operating switch 9. Once the switch 9 is activated, internal circuitry contained within the vibrator forming the operating state change device is activated to perform one of the operations illustrated in one or more of Figs. 3A - 3D to periodically and automatically reverse the direction of motor rotation without further manual input.

Jordan et al. does not disclose any structure that is capable of automatically reversing the direction of operation of the exciter at periodic time intervals as is called for in the pending claims.

In rejecting claim 1, the Examiner asserts that "As the operating state change device is not one of the required elements of the claim, but instead is something with which the claimed device can be used during intended operation, reference not disclosed [sic] such a device can still anticipate the claim." Although Applicant believed that that the Examiner's interpretation was not well founded, Applicant attempted to render the issue moot by amending the disputed limitation of claim 1 to include essentially the same language found in claim 17 -- only to receive an Advisory Action refusing entry of the amendment because the amendment allegedly raised new issues requiring additional search or consideration. While Applicant fails to see how "tweaking" the language of a disputed clause of one independent claim to include at least essentially the same language found in another independent claim raises new issues, Applicant has now reverted to the original language of the disputed clause and asserts that the Examiner's interpretation of that clause is untenable. Although the disputed clause may be preceded by the term "wherein", the only reasonable interpretation is that claim 1 unequivocally recites a structural element in the form of an operating state change device and additionally identifies functions performed by that device. Claim 1 was and remains in this regard no different in scope than claim 17.

Applicant submits that claim 1 as previously presented prior to applicant's attempt to placate the Examiner and as now presented, as well as claim 17 as previously presented, are undeniably novel over the prior art when those claims are properly construed. Specifically,

Jordan et al. lacks any device or structure that is capable of automatically reversing motor direction at periodic time intervals as is called for in the pending claims. Jordan et al. instead discloses a device in which the exciter can be operated in a first mode for compacting fluid materials and a second mode that is more applicable for pushing or distributing than compacting the material. Jordan et al. c. 1, l. 65 – c. 2, l. 17. Switching between the first and second modes is performed by reversing the direction of motor rotation to vary the position of a first mass 9 relative to a second mass 8. Rotation of the motor in a first direction places the masses in the configuration of Fig. 2a to generate a first vibration amplitude to effect operation in the first mode. Id. C., 4, ll. 4-11. Rotation of the motor in the opposite direction places the masses in the configuration of Fig. 2b to generate a second vibration amplitude to effect operation in the second mode. Id. c. 4, ll. 12-16. There is no reference in Jordan that switching between the first and second modes is either automatic or periodic. Nor is any structure disclosed in Jordan that could effect automatic or periodic switching. Indeed, the only logical configuration of Jordan would be to provide a *manually* operated switch in order to permit the operator to choose between the two modes of operation at a time of his or her choosing – in direct contravention to the claimed invention in which.

Jordan et al. further describes that the device is operable at one of two preselected frequencies depending on the direction that the motor is rotating in order to optimize operation within the selected mode. Id. c. 2, ll. 18-29 and c. 4, ll. 28-44. While this frequency selection may be automatic, it is dependent only on the direction of motor rotation as selected by the operator. As such, this frequency selection does not reverse the motor (automatically or otherwise) and is not periodic in nature. The previously submitted §132 Declaration clearly discusses the disclosure of Jordan et al. in the context of one skilled in the art and in the appropriate context rather than a piecemeal assessment of isolated statements therefrom. There is no disclosure in Jordan et al. that the operating direction is periodically and automatically reversed as is called for in the pending claims.

The Examiner has ignored the above described differences between the claimed invention and Jordan because they are allegedly functional in nature. This was clear error. MPEP §2173.05(g) expressly authorizes an applicant to define something by what it does rather than

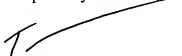
what it is. MPEP §2173.05(g) further requires that “A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” In addition, a prior art reference cannot be used to support a rejection based on anticipation where, as here, the cited reference is *incapable* of performing the claimed function. MPEP §2112 and *In re Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432. The previously-submitted §132 Declaration conclusively established that *no structure* of Jordan et al. is disclosed that renders Jordan et al. capable of automatically and periodically reversing the direction of operation of the exciter as is expressly called for in the pending claims. See Paragraphs 6-9 and especially paragraphs 7 and 8 of the Declaration.

During the telephone interview of September 7, 2010, the Examiner appeared to take the position that (if understood correctly by Attorneys Deheck and Newholm) a manually activated switch, operated by hand in one manner for a period of time to generate a first output and then manually manipulated in another manner for a period of time to generate a second output, would constitute the claimed automatic and periodic motor reversal. Applicant finds such interpretations of “automatic” and “periodic” beyond reasonable and inconsistent with the present disclosure. Once the motor is activated to rotate in a given direction, it runs in that direction unless and until the operator intervenes to reverse the direction of motor rotation. That manually commanded reversal cannot be considered “automatic” and “periodic” within any accepted definition of those terms and certainly not within the contexts of the present application.

For the reasons stated above, applicant believes that the final rejection contains clear factual and legal errors requiring withdrawal of the rejection and allowance of claims 1 and 17 and the claims that depend therefrom, are in condition for allowance. Accordingly, Applicant respectfully requests the Panel’s instructions to that effect.

As indicated above, the Director is authorized to charge the amount of \$540.00 for the Notice of Appeal submitted herewith. Although no other fees are believed due, the Director is further Authorized to charge any fees which may be considered due, or credit any overpayment, with this or any future communication, to Deposit Account No. 50-1170. Applicant appreciates the Panel's time and consideration with respect to this matter and invites any member of the Panel to contact the undersigned should any matters remain which would hinder or otherwise delay passage of this matter to issuance.

Respectfully submitted,



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Date: September 7, 2010

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